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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/455,806	12/07/1999	JOHN L. BEEZER	3797.84617	5592

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EXAMINER

THAI, HANH B

ART UNIT PAPER NUMBER

2171

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/455,806

Applicant(s)

BEEZER ET AL.

Examiner

Hanh B Thai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 6) ☐ Other: _____

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This is in response to the application filed December 7, 1999 in which claims 1-24 are presented for examination.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe et al. (U.S. Patent no. 5,737,599) in view of Hansen et al. (U.S. Patent no. 5,832,263).

1. Regarding claims 1 and 11, Rowe discloses a computer-implemented method for annotating a system having a display for displaying a page having objects, said objects stored in a non-modifiable portion of a file, comprising the steps of:

- receiving a designation of an object of said objects on the displayed page (see col. 16, lines 61-67, Rowe);
- receiving an annotation (see col.34, lines 5-30, Rowe);
- determining a position of the object (see Fig.15A and col. 5, lines 27-36, Rowe);
- storing the position and the annotation separately from the non-modifiable portion of the file (see col.12, lines 48-59, Rowe).

Rowe, however, does not explicitly disclose "the object in the non-modifiable portion". Hansen, on the other hand, discloses this limitation (see col.2, lines 17-21, Hansen). It would

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have been obvious to one of ordinary skill in the art at the time of the invention to modify Rowe to include the non-modifiable object. The motivation of doing so would have been for security purposes of not modifying the object.

2. Regarding claims 2 and 12, Rowe/Hansen combination further discloses that the object is received through interaction with a stylus (see col.10, lines 34-39, Rowe).
3. Regarding claims 3 and 13, Rowe/Hansen combination further discloses that the object is received through interaction with a mouse (see col.10, lines 34-39, Rowe).
4. Regarding claims 4 and 14, Rowe/Hansen combination further discloses that the annotation is a highlight (see col.12, lines 26-36, Rowe).
5. Regarding claims 5 and 15, Rowe/Hansen combination further discloses that the annotation is a bookmark (see col.11, lines 49-56, Rowe).
6. Regarding claims 6 and 16, Rowe/Hansen combination further discloses that the annotation is a drawing (see col.32, lines 36-54, Rowe).
7. Regarding claims 7 and 17, Rowe/Hansen combination further discloses that the annotation is a text annotation (see col.32, lines 36-43, Rowe).
8. Regarding claims 8 and 18, Rowe/Hansen combination further discloses counting the number of bytes from the beginning of the non-modifiable portion of the file to the selected object (see col.35, lines 38-59, Rowe).
9. Regarding claims 9 and 19, Rowe/Hansen combination further discloses the steps of:
 - counting the number of bytes from the beginning of the non-modifiable portion of the file to a first object on the displayed page object (see col.35, lines 38-59, Rowe);

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- counting the number of bytes from the first object on the displayed page to the selected object;
- adding the number obtained from said first counting step to the number obtained from said second counting step to determine the file position of the object in said file (see col.37, line 66 to col38, line 28, Rowe).

10. Regarding claims 10 and 20, Rowe/Hansen combination further discloses that annotation is an annotation of the object (see col. 39, lines 47-55, Rowe).

11. Regarding claims 21 and 23, A computer-readable medium having stored thereon data structures comprising:

- a first data structure having non-modifiable content (see col. 38, line 47 to col. 39, line 7);
- a second data structure having modifiable content, said second data structure including at least a third data structure having a file position indicator that references a file position in said first data structure and a fourth data structure including an annotation (see col.39, lines 42-47 and 57-65). Please note that the “first data structure” corresponds to “first object”.

12. Regarding claims 22 and 24, Rowe/Hansen combination further discloses that the annotation is relevant to the object at the file position (see col.5, lines 27-36 and col. 39, lines 57-65, Rowe).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh B Thai whose telephone number is 703-305-4883. The examiner can normally be reached on 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-9099 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Hanh Thai *HT*
Art Unit 2171
April 14, 2003



SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100